Supreme Court, U.S.

001394 JAN 16 2001

OFFICE OF THE CLERK

No.

In the Supreme Court of the United States

DR. CHACKO P. ZACHARIAH,

Petitioner,

v.

COMMISSIONER OF PATENTS AND TRADEMARKS,
JAMES O.THOMAS, JR., DAC for patents,
CHARLES PEARSON, Head PCT Legal &
Office of Administrator of Legal Affairs,
RICHARD B. LAZARUS, Supervisor PCT Legal, and
UNITED STATES ATTORNEY GENERAL,

Respondents.

On Petition for a Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

DR. CHACKO P. ZACHARIAH
Pro se Petitioner
6365 Bay Club Drive
Fort Lauderdale, Florida 33308
(954) 491-1165

49 pp

QUESTIONS PRESENTED

I. Did the Appeals Court err in affirming the decision of the District Court dismissing pro se petitioner's claims for civil rights violations and abuse of power, as well as for compensation for damages including monetary damages, and for Writ of Prohibition against such continued violations, on the grounds they are not ripe for review and unexhausted, especially when respondents themselves repeatedly told petitioner to go to court?

Did the Courts err in simply ignoring petitioner's repeated pleadings for review and adjudication of these claims, in contravention of Supreme Court's precedents mandating liberal construction of pro se complaints?

II. Does the United States Patent and Trademark Office's (PTO) unilateral revocation and abandonment, without any due process, of a patent application, two years and nine months after PTO accepted it as properly filed and issued five constructive notices to that effect, violate the Fifth Amendment to the U.S. Constitution, Patent Cooperation Treaty Articles and its Regulations, PTO's own Manual of Patent Examining procedures, 35 USC, 37 CFR, and APA §§704,706?

PARTIES TO THE PROCEEDINGS

All parties to the proceedings in the Court whose judgment is sought to be reviewed are accurately reflected in the caption of the case.

CORPORATE DISCLOSURE STATEMENT

There are no corporations involved in this case.

TABLE OF CONTENTS

Questions Presented i

Parties to the Proceedings ii

Corporate Disclosure Statement ii

Table of Contents iii

Table of Authorities v

Opinions Below 1

Jurisdiction of the Court 1

Constitutional Provisions, Treaties, Statutes 1

Statement of the Case 1

Reasons for Granting Writ - Question I 4

Reasons for Granting Writ - Question II 7

Conclusion 14

Appendix 1a

Decision of the Court of Appeals for the Federal Circuit entered on August 8, 2000 .....1a

Denial of Combined Petition for Panel Rehearing and Rehearing En Banc entered on October 18, 2000.....6a

TABLE OF CONTENTS (Contd.)

District Court's Decision Denying Petitioner's Motion to Clarify, Reconsider, and Reinstate, entered on September 8, 1999.....8a

District Court's Decision Granting Respondents' Motion for Summary Judgment and Closing the Case, entered on October 16, 1998.....9a

District Court's sua sponte Decision Dismissing the Case and Closing the Case, entered on August 29, 1997.....17a

District Court's Decision Partially Granting Respondents' Motion to Dismiss, entered on October 16, 1996.....19a

District Court's Decision Ordering Petitioner to File an Amended Complaint, entered on December 19, 1995.....24a

Return Receipt Post Card Showing Proof of PTO's Receipt of Petitioner's Declaration for his Original PCT International Application.....26a

TABLE OF AUTHORITIES

Cases **Page**

Association of National Advertisers, Inc. v. FTC, 627 F.2d 1151, 1157-1158 (App. D.C. 1979), cert. Denied, 447 U.S. 921 (1980) 6

Caterpillar Tractor Co. v. Commissioner of Patents & Trademarks, 650 F. Sup. 218 (ED. Va. 1986) 8

Commissariat A L'Energie Atomique et. al. v. Watson, 274 F.2d 594,597 (D.C.Cir.1960)..... ...13,14

Gibson v. Berryhill, 411 U.S. 564, 575 (1973).....6,11

In re Donaldson Co., 29 USPQ 2d 1845,1848 (Fed.Cir.1994) 9

Haines v. Kerner, 404 U.S. 519 (U.S. 1972) 5

Helfgott, et. al v. Dickinson, 54 USPQ 2d 1425, 209 F.3d 1328 (Fed Cir. 2000) 8

Houghton v. Shafer, 392 U.S. 639,640 (1968).....6,11

Howard v. Hodgson, 490 F.2d.1194 (C.A.8.Mo 1974) 13

Hughes v. Rowe, 449 U.S. 5 (U.S. 1980) 5

Juidice v. Vail, 430 U.S. 327, 338 (1977) 6,12

Loveladies Property Owners Assn.Inc., v. Raab,
430 F.Supp 276, (D.C.NJ 1975); Affirmed
547F.2d. 1162, Cert. Denied 432 US 906 13

Mansell v. Mansell, 490 U.S. 581,592(1989) 9

Margolis et al. v. Banner,
599 F.2d.435, 202 USPQ 365(CCPA 1979) 13,14

McCarthy v. Madigan,
503 U.S. 140 (1992).....5,6,11,12

National Farmers Union Ins. Cos. v. Crow Tribe
of Indians, 471 U.S. 845, 856 n 21(1985) 5,12

New South Indus. v. Apache Grounding Corp.,
666 F. Supp. 1067 (M.D. Tenn. 1987) 9

Pacemaker Monitor Corp. v. U.S.,
440 F.Supp.473 (S.D.Fla.1977) 5,14

Patsy v. FAU, 634 F. 2d 900, 912-913
(en banc CA5 1981).....6,12

Rasmussen v. Seamans,
432 F.2d.346; (C.A.10.Colo.1970) 13

In re Searles, 164 USPQ 623 (1970) 8,9

In re Way, 514 F.2d 1057 (C.C.P.A. 1975) 9

Zachariah v. Commissioner of Patents, et.al.,
42 USPQ 2d 1313; 990 F.Supp.1404
(D.C. Fla. 1996) 1,3

Treaty, Statutes, Rules

Patent Cooperation Treaty (PCT) .....passim

Patent Cooperation Treaty (PCT) Article 26.....7,8

Patent Cooperation Treaty
Applicant's Guide Vol II, ¶38 8

U.S. Constitution .....passim

U.S. Constitution - Due process clause .....passim

U.S. Constitution - Takings clause 13

Administrative Procedure Act [5 USC §§704,706].....1

28 USC §1361.....14

28 USC §1254 (1).....1

35 USC .....passim

42 USC §1985 1

37 CFR .....passim

Rule 8(f) of the Fed. R. Civ. P 5

Manual of Patent Examining Procedures
(MPEP)..... ...passim

Supreme Court Rule 10a 1

Federal Circuit Rule 28(b) 4

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit of August 8, 2000 was reported on the Internet at http://www.bannerwitcoff.com/cases/patent/00-1061.pdf and http://www.finnegan.com/cases/00-1061.htm. District Court's decision partially granting Respondents' Motion to Dismiss was reported at *Zachariah v. Commissioner of Patents, et.al.*, 42 USPQ 2d 1313; 990 F.Supp.1404 (D.C. Fla. 1996). District Court's decision Granting Summary Judgment to Respondents was not reported (see 8a - 25a).

JURISDICTION OF THE COURT

Petition for a Writ of Certiorari is sought pursuant to 28 USC §1254(1) and Supreme Court Rule 10 (a) from the Decision of the Court of Appeals for the Federal Circuit entered on August 8, 2000 and the Denial of Combined Petition for Panel Rehearing and Rehearing En Banc entered on October 18, 2000.

CONSTITUTIONAL PROVISIONS, TREATIES, STATUTES

Patent Cooperation Treaty (PCT), U.S. Const. 5th Amend., 35 USC, and 37 CFR, 42 USC §1985, APA §§704,706.

STATEMENT OF THE CASE

Petitioner, a US citizen, and a scientist and inventor, on August 28, 1990, filed an International Patent Application under the Patent Cooperation Treaty (PCT), seeking a patent on a system to recycle nuclear wastes. The respondents, U. S. Patent & Trademark Office (PTO), acted as the Receiving Office (RO), International Searching Authority (ISA), and the International Preliminary Examining Authority (IPEA), for PCT, and processed the application pursuant to the PCT during a

30-month period. Application then entered the National Phase in all the countries which petitioner had selected, including the USA. Petitioner's Application entered the national phase in USA from PCT on April 16, 1992, in full compliance with the requirements of Patent Cooperation Treaty and the US requirements under 35 USC §§371, 372. Respondents accepted it and then issued five constructive notices: (i) Notification of Acceptance of Application under 35 USC §371 and 37 CFR §1.495. (ii) Filing Receipt on "Form PTO-103X". (iii-v) Two different Commissioners of PTO assured the U. S. Senators Connie Mack and Phil Gramm who inquired on behalf of petitioner, through three letters signed by the Commissioners in December 1992 and again in late 1993, that "*the application was in order, the required administrative processing of the application had been completed, it had entered the national phase, and had been sent for examination.*" Two and a half years later, the same PTO examiner, who earlier acted as ISA and IPEA under PCT, issued an office action in the national phase to which petitioner responded.

However, about two years and nine months after the said acceptance in the National Phase, and three months after Petitioner's said response to examiner's office action -- without any due process and in direct violation of the U.S. Constitution, PCT Articles and its Regulations, 35 USC, and 37 CFR, MPEP -- the respondents revoked the filing and simply held the application abandoned, by issuing a "Notice of revocation and abandonment". Respondents gave the petitioner no opportunity to correct, as the treaty requires, in case there was a defect.

During his efforts to reinstate the application, respondents threatened and harassed petitioner and their actions showed intent to harm and acts in furtherance of a conspiracy to harm a citizen and obstruct justice, and discrimination. Some of the respondents' (who are lawyers) statements to petitioner included:

"It will cost you an awful lot of money to prove that we are wrong."

"If you say they can't do this, we will show you we can do this."
"You will have to tell that lie. You will have to tell it one day."
"There are some awful people in government."
"Where were you born?"
"You could disagree until you are pink in the face."
"You can argue till you are blue in the face."

Responding to petitioner's petition of December 5, 1994 to withdraw their "Notice of Revocation and Abandonment", respondents issued a 2nd decision, on January 3, 1994[5] denying petitioner's said petition and reaffirming their earlier decision. Respondents themselves told petitioner to go to court and also that they will never let petitioner win in court. Petitioner had by then exhausted all administrative remedies.

Therefore, petitioner filed suit on January 17, 1995, in District Court in S.D. Florida under the constitution, laws, and treaties of the United States seeking a declaratory judgment and injunctive relief, as well as monetary damages, on claims including civil rights. Petitioner's claims included claims for civil rights violations and abuse of power, for relief as well as for compensation for damages including monetary damages, and for Writ of Prohibition against such continued violations. Upon respondents' motion, the district court dismissed counts III and IV of the petitioner's amended complaint on ripeness grounds, stating that the petitioner failed to exhaust administrative remedies with the PTO; *Zachariah v. Commissioner of Patents, et.al.*, 42 USPQ 2d 1313 (D.C. Fla. 1996). This was error, as the PTO is unable to provide the relief sought in counts III and IV -- a writ of prohibition, monetary damages, and an injunction. Further, count III alleged a claim seeking monetary damages, a remedy which only could be provided by the court. Counts III and IV stated claims upon which relief should be granted, and sought relief which the PTO could not provide. Petitioner filed a motion to reconsider, which was denied.

The district court also granted the respondents' motion for summary judgment as to counts I and II. Genuine issues of material fact exist which preclude summary judgment. Finally, the district court erred in failing to issue a writ of mandamus directing the respondents to reinstate petitioner's application. Petitioner's motion to reconsider was denied.

Petitioner then appealed to the U. S. Court of Appeals for the Federal Circuit, which affirmed the lower court decisions. Petition for panel rehearing and rehearing En Banc were denied on October 18, 2000. Neither the District Court nor the Appeals Court ever granted a hearing on the matter even after repeated requests by petitioner nor did they ever mention one word in any of their decisions on his claims for civil rights and monetary damages even though petitioner raised them in numerous pleadings. Courts' decisions were in plain contravention of the requirements of the Constitution of the United States, PCT, & federal law.

I. REASONS FOR GRANTING WRIT - QUESTION I

Petitioner had raised the issues of violations of his rights including civil rights, and sought monetary damages, in his Principal and Reply Appeal Briefs, Complaint, and Amended Complaint, and in all his pleadings. Respondents never denied, disputed, objected, or rebutted the truth as to these highly improper actions and arguments and claims presented by petitioner to this evidence. By their decisions the Courts denied these claims without stating any grounds or reasons and erred when they said it is not ripe for review regarding Claim III and again when they granted Summary Judgment on Claim I. These claims must be adjudicated by trial for damages and, therefore, the Court's affirmation of summary judgment was in error. The Court simply ignored Petitioner's request for relief for respondent's violation of Petitioner's civil rights and the damages therefor. Significantly, as per Fed. Cir. R. 28(b),

respondents did not contest, and hence, must be taken to have conceded that the district court erred on this issue. At no time has Petitioner given up his claims on this issue. Dismissing petitioner's claims, without offering even the slightest reason for such action by the courts, in the face of demonstrated evidence of pervasive bias, without trial, was an abuse of discretion. See *McCarthy v. Madigan*, 503 U.S. 140 (1992).

Further, it is well established that Pro-se Complaints must be liberally construed. Rule 8(f) of the Fed. R. Civ. P. directs courts to construe pleadings so as to do substantial justice. When a petitioner is a pro se litigant, a district court has a special obligation to construe the complaint liberally and offer every reasonable opportunity to demonstrate that they have a valid claim. The allegations of a pro se complaint are held to a less stringent standard than formal pleadings drafted by lawyers. *Haines v. Kerner*, 404 U.S. 519 (1972); Hughes *v. Rowe*, 449 U.S. 5 (1980).

Also, by statute and case law Petitioner can come to Federal Court and has standing when officials do any of the following: *show bad faith or bias, violate provisions of any [PCT] treaty and U. S. Constitution, demand petitioner to do illegal actions and agree to their false statements or lie under oath, violate his due process rights, violate or conspire to violate his constitutional rights, confiscate his property without any due compensation, cause irreparable injury, abuse or exceed their power or authority, threaten petitioner, conduct unauthorized actions, or has otherwise predetermined issues, etc., besides final actions.* Respondents' actions were arbitrary, capricious, gross abuse of discretion, biased, contrary to law, and were unconstitutional and there is demonstrated evidence to substantiate them. See *McCarthy v. Madigan*, supra; *Pacemaker Monitor Corp. v. U.S.*, 440 F.Supp.473 (S.D.Fla.1977). Exhaustion is not required where an assertion ... is motivated by a desire to harass or is conducted in bad faith; *National Farmers*

Union Ins. v. Crow Tribe of Indians, 471 U.S. 845, 856 n 21(1985); *Juidice v. Vail,* 430 U.S. 327, 338 (1977).

The district court erred in not issuing a Writ of Prohibition prohibiting the respondents from carrying out their plans for, and continuing their pattern of, threats, harassment, intentions to harm petitioner and violating petitioner's rights including civil rights, acts in furtherance of a conspiracy to harm a citizen, and discrimination, which the respondents did not deny. This was included in Petitioner's Count III, which is ripe for review any time and demands judicial review. Respondents' threats were set forth in the Complaint and were part of sworn affidavits in several pleadings in the district court's records. Petitioner demonstrated the bias on part of the respondents and, therefore, dismissing his claims, without stating any reasons in the face of allegations of pervasive bias, was an abuse of discretion. See *McCarthy v. Madigan,* 503 U.S. 140 (1992). By its decision the Court denied these claims without any grounds and court erred when it said it is not ripe for review regarding Claim III. Respondents have not responded to any of the arguments or authorities set forth on these issues in Petitioner's Prin. Brief at 25-33, and thus implicitly conceded these issues to the petitioner.

Exhaustion i. futile where an agency is shown to be biased or has otherwise predetermined the issue; *Gibson v. Berryhill,* 411 U.S. 564, 575 (1973); *Houghton v. Shafer,* 392 U.S. 639,640 (1968); *Association of National Advertisers, Inc. v. FTC,* 627 F.2d 1151, 1157-1158 (App. D.C. 1979). Administrative procedures must not be used to harass or otherwise discourage those with legitimate claims; *Patsy v. FAU,* 634 F. 2d 900, 912-913 (en banc CA5 1981). Also, petitioner was told to go to court.

Petitioner's claims included claims for civil rights violations and abuse of power, for relief as well as compensation for damages including monetary damages [*and for Writ of Prohibition against such continued violations*]. These are factual claims. The proof of the district and appeals courts misapprehending the

complaint is demonstrated at ¶3 on pages 3a and 5a of the Court's opinion where the Court enumerates what it perceives to be the petitioner's claims, and omitted any discussion of petitioner's civil rights claims and claims seeking monetary damages. The undisputed evidence showed the existence of genuine issues of material fact, and the court failed to adjudicate the real claims.

II. REASONS FOR GRANTING WRIT - QUESTION II

Respondents made grievous error with respect to four issues by their decision to unilaterally revoke and abandon petitioner's patent application that entered the national phase in USA from PCT. They include violations of: (a) PCT, (b) US Constitution and 35 USC, 37 CFR and PTO's internal operating rules and procedures, (c) Statutory requirement of Declaration/oath, (d) Predetermining "New Matter". First, if there was an error, they had to provide petitioner an opportunity to correct the error as required by PCT, and also by US laws. Second, there was no error. Third, Respondents said the declaration/oath must be made to an exact copy of the international application, which is in clear contradiction to the wording of the US statutes which only require a declaration/oath to the invention and not the application. Fourth, PTO asked petitioner to file under oath that his application contained new matter when in fact it doesn't contain new matter and they admitted in court they never looked at it to see if there is new matter.

PCT, US Constitution, Statutes, 37CFR, MPEP:

The Governing PCT Treaty states in its Article 26: "No designated Office shall reject an international application on the grounds of non-compliance with the requirements of this treaty and the Regulations without first giving the applicant the opportunity to correct the said application to the extent and according to the

procedure provided by the national law for the same or comparable situations in respect of national applications."

Once an application has entered the National Phase, if there is a defect in say, the declaration, Manual of Patent Examining procedures (MPEP) ¶602 tells how to cure it (for regular national filings/applications also). The Examiner is allowed to waive all minor deficiencies as per Form Paragraph ¶6.05 under MPEP ¶602.03. Examiner can ask for a substitute oath or declaration under MPEP ¶602.02. The Examiner is allowed to ask for clearing even major defects in the declaration as late as when the application is ready for issue as a patent, all at no cost to the applicant. Some deficiencies are self-evidently cured in the rest of the declaration, MPEP ¶602.03. See *In re Searles*, 164 USPQ 623 (1970). In the present instance, the application entered the national phase and was with the examiner for over two years. (p2 ¶1 lines 15-18 above)

Caterpillar Tractor Co. v. Commissioner of Patents & Trademarks, 650 F. Sup. 218 (ED. Va. 1986) establishes that PCT treaty is the governing law and its provisions are dominant over the statutes and PTO rules and regulations. PCT Applicant's Guide, [see its significance discussed in *Helfgott, et. al v. Dickinson, 209 F.3d 1328 (Fed Cir. 2000)*], Volume II, ¶38, says that the only requirements for entry into the national phase are payment of the national fees, the furnishing of a translation, and the *indication of the name and address of the inventor*. PCT only requires an "indication", not a declaration or oath. For all other requirements, an invitation must be extended to the inventor of usually two months. See PCT Art 26.

35 USC §371(d) and 37 CFR §1.495 along with MPEP §1893.01(b) state clearly that if Applicant omitted to pay fees, & omitted to file an application, and omitted an oath, then the Commissioner must invite the applicant to comply with those requirements, by such later time as may be fixed by the commissioner, and if applicant fails to comply, then the application becomes abandoned. i.e.,

Due process and procedure to follow. Did they follow them? Absolutely not! "When statutory interpretation by Commissioner is at issue, the plain and unambiguous meaning of statute prevails in the absence of clearly expressed legislative intent to the contrary"; *In re Donaldson Co.*, 29 USPQ 2d 1845,1848 (Fed.Cir.1994) *and Mansell v. Mansell*, 490 U.S. 581,592 (1989). If respondents' arguments and court's rulings were correct, they would be ultra vires and a clear violation of PCT and 35 USC §371. Thus according to the respondents and the court if petitioner had omitted to do all three, he would be in a better position, and his application would not have been abandoned by the PTO! If Petitioner filed the declaration which respondents contend is defective, why is he worse off than if he had filed no oath/declaration at all? Respondents were estopped from doing what they did by law and their own actions. They were prohibited from doing what they did by case law; see *In re Way*, 514 F.2d 1057 (C.C.P.A. 1975); *Mansell v. Mansell, supra; New So. Indus. v. Apache Grounding Corp.;* 666 F. Supp. 1067 (M.D. Tenn. 1987); and *In re Searles*, supra. Further, they were time barred from doing what they did.

Statutory Requirement of Declaration/Oath:

Respondents' decision revoking and abandoning the patent application on the ground that the petitioner's oath (on PTO form) was defective (saying it must be to a precise copy of the international application), violated the PCT and the federal patent statutes.

This position of the PTO is contrary to the statute, which clearly states that the oath must be to the *invention.* They repeated these same arguments in court in several of their pleadings. Courts simply ignored petitioner's objections. The declaration/oath requirement of: 35 USC §371(c) (4), 37 CFR §1.475, 37 CFR §1.63, and 37 CFR §1.497, is satisfied according to 35 USC §115; and its relevant first sentence is:

> "The applicant shall make oath that he believes himself to be the original and first inventor of the

process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent: and shall state of what country he is a citizen."

The text of 35 USC §371(c)(4) reads:

"(4) an oath or declaration of the inventor ...complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants."

The oath or declaration submitted by Petitioner was on a form issued by the PTO and, therefore, fully complied with the regulations for oaths and declarations. Thus in addition to meeting all the requirements for entry into the national phase from PCT as required by PCT, he submitted a declaration satisfying the requirements of 35 USC §371(c) (4), 37 CFR §1.475, 37 CFR §1.63, 37 CFR §1.497, and 35 USC §115 as shown above. Petitioner thus met all the conditions, 1000% over and above the requirements of PCT, 35 USC and 37 CFR.

The petitioner had satisfied all the requirements for entry into the national phase in US. PTO had in its possession a copy of the original PCT application under 35 U.S.C. 371(c)(2). Petitioner paid the fees. The petitioner had satisfied the oath requirements for entry into the national phase since PTO had in its possession as many as SIX oaths *for the invention in his original PCT application* as required under 35 USC §371(C)(4) and 37 CFR §1.63. [Four of these oaths were filed with the PTO during prosecution in the PCT international phase as well as later in the national phase, with respect to national security matters. Six oaths were filed because PTO kept losing the papers, which were filed. Every single one of these 6 oaths was an oath to the invention in the original international patent application, all of which PTO disregarded.] The respondents had in their possession an oath for the original PCT application as far back as 28 August 1990 as evidenced by the Stamped Return Receipt Post Card showing receipt of said oath by PTO, which was in evidence in both the district and

appeals courts, (p 26a). PTO and the courts totally ignored this. Thus contrary to the contentions of the respondents and the opinion of the Appeals Court at p 5a, ¶1, lines 1-2, petitioner satisfied all the requirements for entry into the national phase in US; thus creating genuine issues material facts in dispute.

There is no logical connection or basis between the number of claims and the rationale for the Court's ruling (paragraph bridging pages 4a & 5a of its opinion) that petitioner's oath is not for the international invention and thus did not satisfy 35 USC §371(c)(4). Statute does not say the same number of claims must be present, instead the statute says clearly that the oath must be *to the invention*; [not to an application or to a copy of the application]. 37 CFR §1.63, 35 USC §115. It is just common sense, that an inventor's oath that covers X + Y number of claims (or original + additional material) surely covers X claims and original material.

Predetermination of "New Matter":

Respondents also *repeatedly demanded that petitioner lie under oath if his application has to be reinstated in some form.* The lie which respondents wanted petitioner to tell was that the national phase application contained new matter. Respondents in their 3 decisions and 3 options state there is new matter in his application. Then they came to court and stated the same. When petitioner challenged these statements in court, they and their lawyers - then numbering about one and a half dozen - made a new argument *that when they said new matter, they didn't mean it that way.* They later said it is *additional material,* it is *substantially different,* and *we never looked at it.* Then one page later in their same brief *they would again say it is new matter* and *2 paragraphs later "we didn't look at it!* " Exhaustion is futile where an agency is shown to be biased or has otherwise predetermined the issue; *Gibson v. Berryhill,* 411 U.S. 564, 575 (1973); *Houghton v. Shafer,* 392 U.S. 639,640 (1968); *McCarthy v. Madigan,* supra.

Further, petitioner would like the Court to know that the statutes 37 CFR §§1.68, 1.137 require that *all petitions to Commissioner must be by "verified showing if made by a person not registered to practice before PTO". Respondents demanded repeatedly during their threatening conversations that petitioner admit under oath that "what was present in 1990", is "new matter" in 1992 and 1994 by swearing under oath that it was not present in 1990!* Even though respondents had predetermined the issue (that it is new matter), and in the face of such predetermination it is futile to ask them for another "determination of the issue", petitioner never asked the court to issue a Writ of Prohibition preventing the respondents from determining if there is new matter. Petitioner's Writ of Prohibition was to prevent the respondents from continuing their harassment, threats, etc. as explained at pages 5-6 above.

Respondents themselves told petitioner to go to court and also that they will never let petitioner win in court. Case law also says that when agency officials do not follow procedure governing their conduct or forces you to do something illegal, causes irreparable injury, violate due process, etc. even once, it is ripe for court review. Exhaustion is not required where an assertion ..... is motivated by a desire to harass or is conducted in bad faith; *National Farmers Union Ins. Cos. v. Crow Tribe of Indians,* 471 U.S. 845, 856 n 21(1985); *Juidice v. Vail,* 430 U.S. 327, 338 (1977). Administrative procedures must not be used to harass or otherwise discourage those with legitimate claims; *McCarthy v. Madigan,* supra; *Patsy v. FAU,* 634 F. 2d 900, 912-913 (en banc CA5 1981).

Other Issues:

Three months after this lawsuit was filed and in response to said lawsuit, respondents issued a 3rd decision (reaffirming their earlier 2 decisions) in which they included a new 3rd option, as stated in District Court's order of December 19, 1995 (p25a, ¶1). Thus the third option offered by Respondents was prompted by the

fact that Petitioner was forced to proceed in Court because of their unlawful first 2 decisions and their onerous first 2 options; contrary to the court's opinion at *p 3a, ¶2, lines 7-8.*

In their 3 options, respondents said: "file CIP applications". CIP (continuation-in-part) applications are applications which are filed during the lifetime of a pending earlier parent application. 37 CFR §1.78 & 35 USC §120. The instant case is not such a case at all. Here the Respondents have taken it upon themselves to revoke and abandon petitioner's national phase entry application. There are no provisions in the statute for filing a CIP application when the parent application does not exist and has been revoked and abandoned by PTO.

Further, Patent laws regarding patent terms were changed after the respondents revoked and abandoned the application. If petitioner were to accept the third option, what security would petitioner have that the PTO would not curtail his patent term under the new law?

Additionally, taking any of respondents' options makes the petitioner give back several years of his patent term to the public domain - "disclaimer"; resulting in harm & irreparable injury, a violation of the takings clause of the Fifth Amendment.

Further, these clearly demonstrate the futility of exhaustion of remedies at PTO and certainly any further efforts would have been futile in light of respondents' threats and their demonstrated pervasive bias.

Mandamus is the proper remedy in this case, See: *Margolis v. Banner, Commissioner of PTO,* 599 F.2d.435, 202 USPQ 365(CCPA 1979); *Commissariat A L'Energie Atomique V. Watson,* 274 F.2d 594,597 (D.C.Cir.1960); *Howard v. Hodgson,* 490 F.2d.1194; (C.A.8.Mo 1974); *Loveladies Property Owners Assn. Inc., v. Raab,* 430 F.Supp 276, (D.C.NJ 1975); affirmed 547F.2d. 1162, Certiorari denied 432 US 906; *Rasmussen v. Seamans,* 432 F.2d.346; (C.A.10.Colo.1970).

In *Margolis. v. Banner, supra* the petitioners were *only threatened with abandonment* of the application - *a*

threatened injury - and the Appeals Court granted a Writ of Mandamus. In the present case, the petitioner has already suffered injury in that the respondents *have revoked the filing and abandoned his application without any due process.* In Margolis, the petitioners were given an opportunity to respond (due process) before taking action and *only threatened with abandonment and still the Federal Appeals Court issued a writ of mandamus. In Commissariat A L'Energie Atomique et.al. V. Watson, supra,* the Circuit Court eloquently stated that PTO Commissioner's denial of petitions is reviewable to see if it lacked any basis in reason or common sense, under 28 USC §1361 mandamus provision. "Mandamus is the proper remedy, when it appears that a federal official may not have complied with procedures promulgated to govern his conduct", *Pacemaker Monitor Corp. v. U.S., supra.* In denying petitioner's claim for mandamus, the Court has failed to point out on what authority respondents had abandoned petitioner's application, without any due process mandated under PCT, U.S. Const. 5th Amend., 35 USC, and 37 CFR.

The appeals court's decision is in conflict with several prior precedential opinions of the Federal Courts of Appeals, including prior decisions of the Federal Circuit itself, and well-established Supreme Court rulings.

CONCLUSION

Respondents' actions will cause irreparable injury to petitioner if the decision of the Appeals court is allowed to stand. Further, in this emerging technology era, intellectual property including patents have become a highly prized and valuable commodity and more and more patent applications are filed world wide under PCT to which US is a party. All countries look towards the USA for guidance and leadership in this area since U. S. is the world's only economic superpower and technological leader. How the US interprets these treaties will guide

other nations and even U. S. applicants when they encounter similar problems here and abroad in the future, even though petitioner had smooth sailing in entering the national phase in all the other (33 major) countries he had selected, without a single objection. The rulings of the Appeals Court for the Federal Circuit are binding on patent matters and this will govern future behavior for PCT applicants and will have significant consequences nationally and internationally and set an example to rest of the countries to follow.

Secondly, it is very important that a US Administrative agency be fair and impartial in dealing with its citizens. Violations of civil rights, due process, and statutes, as well as conduct, by an administrative agency which has become so important to Nation's commerce and capital and wealth formation, should not go unchecked by the courts. The district and appeals courts had an unambiguous and compelling obligation to review the claims of civil rights violations and damages. The appeals Court's decision was a grotesque miscarriage of justice and is inconsistent with accepted Supreme Court precedents, rulings of other Appeals Courts, and common sense.

The U. S. Supreme Court has supervisory authority over the lower courts and should exercise its duty to set this matter right and remove the confusion and chaos it will cause. Petitioner urges that this matter warrants immediate Supreme Court intervention and respectfully requests that the Supreme Court kindly grant writ of certiorari to this petition. Simple justice and due process demand so.

Respectfully Submitted,

January 2001

DR. CHACKO P. ZACHARIAH
Pro se Petitioner
6365 Bay Club Drive
(954) 491-1165 Fort Lauderdale, Florida 33308

NOTE; Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. This disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

00-1061

DR. CHACKO P. ZACHARIAH,

Plaintiff-Appellant,

v.

COMMISSIONER OF PATENTS AND TRADEMARKS, JAMES O.THOMAS, JR., DAC for patents, CHARLES PEARSON, Head PCT Legal & Office of Administrator of Legal Affairs, RICHARD B. LAZARUS, Supervisor PCT Legal, and UNITED STATES ATTORNEY GENERAL,

Defendants-Appellees.

DECIDED: August 8, 2000

Before RADER, SCHALL, and LINN, Circuit Judges.

RADER, Circuit Judge.

Dr. Chacko P. Zachariah appeals the decisions of the United States District Court for the Southern District of Florida, dismissing two counts and granting the Government's motion for summary judgment on the

remaining counts. Because this court concludes that two of appellant's counts are not ripe for review and finds no genuine issue of material fact in connection with the remaining counts, this court affirms.

I.

Dr. Zachariah filed an international application to patent an "element and energy production device" under the Patent Cooperation Treaty (PCT). The PCT process consists of an international and a national stage. During the international stage, the World Intellectual Property Organization (WIPO) preliminarily processes the application under the terms of the PCT. During the national stage, the applicant designates member countries in which the applicant desires patent protection. Thereafter, the patent office of each designated country processes the application under its own patent laws. This appeal concerns Dr. Zachariah's national stage filing. In order to enter the national stage in the United States, an applicant must provide: (1) a national fee; (2) a copy of the international application unless it has already been forwarded to the member country's patent office; (3) any amendments to the international application; (4) an oath asserting that the applicant invented the subject of the application; and (5) translations if necessary. See 35 U.S.C. § 371(c) (1994).

After filing his international application, Dr. Zachariah commenced prosecution of his application in the United States. Dr. Zachariah's national stage application contained twenty claims; however, his international application contained only fifteen claims. The national stage application also contained additional written description not present in his international application. Dr. Zachariah contends that the additional claims resulted from the separation of previously compound claims. Therefore, he asserts, the application contained no "new matter."

On May 6, 1992, the United States Patent and Trademark Office (PTO) accepted Dr. Zachariah's application for prosecution. However, on November 8, 1994, the PTO vacated its acceptance because of differences between the national application and his international application. The PTO rejected Dr. Zachariah's oath because it supported only the invention in the national application, not the invention in the international application. Hence, the PTO determined that the oath did not satisfy the requirements in 35 U.S.C. § 371(c)(4) and 37 C.F.R. § 1.63 (1999).

The PTO offered Dr. Zachariah two options for proceeding with his application. Either he could proceed with the national phase using the original international application, or he could forgo the international filing date and proceed as if the national application was a newly-filed United States patent application. Following Dr. Zachariah's petition requesting review of this revocation, the PTO offered a third option—treating his application as a domestic application but according it an advantageous unity of invention treatment under the PCT.

In lieu of these options, Dr. Zachariah sued the PTO seeking: (1) declaratory judgment that PTO actions and interpretations violated the law, (2) a writ of mandamus directing the PTO to withdraw its decision revoking acceptance, (3) a writ of prohibition preventing the PTO from selectively prosecuting his application, and (4) injunctive relief preventing the PTO from "tampering with the original filing status" of the application. The district court dismissed the latter two counts because they were not ripe for review. See Zachariah v. Commissioner of Patents & Trademarks, 990 F. Supp 1404, 1405–06 (S.D. Fla. 1996). The district court granted the PTO's motion for summary judgment on the remaining counts. See Zachariah v. Commissioner of Patents & Trademarks, Civ. No. 95-6040 (S.D. Fla. 1999).

II.

When reviewing a district court's conclusion that causes of action in a case are not ripe for review, this court applies the law of the regional circuit in which the district court sits. See Cedars-Sinai Medical Center v. Watkins, 11 F.3d 1573, 1580, 29 USPQ2d 1188, 1194 (Fed. Cir. 1993). The U.S. Court of Appeals for the Ninth Circuit reviews de novo a dismissal under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction. See GTE Directories Publ'g Corp. v. Trimen Am., Inc., 67 F.3d 1563 (11th Cir. 1995).

This court also reviews the district court's grant of summary judgment without deference. See Conroy v. Reebok Int'l, Ltd, 14 F.3d 1570, 1575, 29 USPQ2d 1373, 1377 (Fed. Cir. 1994). Summary judgment may stand only if the record shows no genuine issue of material fact and the PTO's entitlement to judgment as a matter of law. See Fed. R. Civ. P. 56(c). The Federal Rules of Civil Procedure also require courts considering summary judgment to draw all reasonable inferences in favor of the non-movant. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986).

III.

The PTO vacated the acceptance of Dr. Zachariah's application for failure to meet the requirements of 35 U.S.C. § 371(c)(4) and 37 C.F.R. § 1.63. Section 371(c) requires an inventor commencing a national application to file a "copy of the international application" and an oath. Section 1.63(a)(2) requires the oath to identify the specification to which it applies. The oath in Dr. Zachariah's national application applied only to his national application. Dr. Zachariah's national application contained more claims than his international application. Dr. Zachariah's national stage application therefore differed from his international application. Because Dr.

Zachariah did not have a declaration covering the invention in his international application and because the national and international applications differ, Dr. Zachariah's oath was insufficient to satisfy § 371(c)(4). The PTO was therefore statutorily barred from accepting Dr. Zachariah's national application.

Dr. Zachariah's first and second counts asked the district court to: (1) declare that the PTO had broken the law, and (2) reverse its actions. Because this court finds that there is no genuine issue of material fact as to whether the PTO's notice withdrawing acceptance was appropriate, this court affirms the district court's summary judgment on both of these counts.

Dr. Zachariah's third and fourth counts ask the district court to restrain the PTO during the prosecution of the patent. The district court dismissed these complaints because it found that the regulatory scheme prevented the court's intervention until after the PTO has issued final agency action.

The act of an agency is reviewable when made reviewable by statute or when it is final. See 5 U.S.C. § 704 (1994). Because there has been no final agency action in the case of Dr. Zachariah's application, the PTO's action is not reviewable in the district courts. There is no construction of the facts that would have allowed the district court to enter judgment for Dr. Zachariah on his third and fourth counts. Therefore, this court concludes that the district court properly dismissed them.

Based on the above determinations, this court affirms the judgments of the district court.

United States Court of Appeals for the Federal Circuit

00-1061

DR. CHACKO P. ZACHARIAH,

Plaintiff-Appellant,

v.

COMMISSIONER OF PATENTS AND TRADEMARKS, JAMES O.THOMAS, JR., DAC for patents, CHARLES PEARSON, Head PCT Legal & Office of Administrator of Legal Affairs, RICHARD B. LAZARUS, Supervisor PCT Legal, and UNITED STATES ATTORNEY GENERAL,

Defendants-Appellees.

ORDER

A combined petition for panel rehearing and rehearing en banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on October 25, 2000.

FOR THE COURT,

sd/ Jan Horbaly
Clerk

Dated: October 18, 2000

cc: Chacko P. Zachariah
Susan L. Christanberry

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
OCT 18 2000
JAN HORBALY
CLERK

ZACHARIAH V COMM OF PATENTS, 00-1061
(DCT - 95-CV-6040)

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

(Order Entered on Sep 8, 1999 as DE # 78)

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 95-6040-CIV-NESBITT

DR. CHACKO P. ZACHARIAH,
Plaintiff,

vs.

COMMISSIONER OF PATENTS AND TRADEMARKS, et. al.,
Defendants.

ORDER

FILED by *mat* D.C.
Sep 8, 1999
Clerk, U.S.District Court
S.D. Fla., Miami.

This cause comes before the Court upon Plaintiff's Notion to Clarify, Reconsider, and Reinstate (D.E. #77), and Plaintiff's Letter Requesting Hearing on the Plaintiff's Motion (D.E. #76).

Plaintiff requests that the Court reconsider its October 15, 1998 Order Granting Defendant's Motion for Summary Judgment (D.E. #75). The Court will not reconsider that Order.

Accordingly, it is hereby ORDERED and ADJUDGED that plaintiff's Motions (D.E. #76, 77) are DENIED.

DONE and ORDERED in Chambers, Miami, Florida, this 7 day of September, 1999.

sd./ LENORE C. NESBITT
UNITED STATES DISTRICT JUDGE

CC: Dr. Chacko P. Zachariah, pro se
Laurie E. Rucoba, AUSA

(Order Entered on Oct 15, 1998 as DE # 75)

CLOSED CIVIL *CASE*

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
CASE NO. 95-6040-CIV-NESBITT

DR. CHACKO P. ZACHARIAH,
Plaintiff,

vs.

COMMISSIONER OF PATENTS AND TRADEMARKS, et. al.,
Defendants.

FILED by *srg* D.C.
Oct 16, 1998
Clerk, U.S.District Court
S.D. Fla., Miami.

ORDER GRANTING DEFENDANT' S MOTION FOR SUMMARY JUDGMENT AND CLOSING CASE

This cause comes before the Court upon Defendants' Motion for Summary Judgment filed February 18, 1997 (D.E.#55), and Plaintiff's Motion for Sanctions filed May 12, 1997 (D.E. #66). After due consideration of the record, Defendants' Motion for Summary Judgment (D.E. #55) is **GRANTED,** Plaintiff's Motion for Sanctions (D.E. #66) is **DENIED** for the following reasons.

FACTUAL BACKGROUND

This suit was filed pro se by Plaintiff Dr. Chacko Zachariah ("Plaintiff") against the Commissioner of Patents & Trademarks; James O. Thomas, Jr., Deputy Assistant Commissioner for Patents; Charles Pearson, Head Patent Cooperation Treaty Legal & Office of Administrator of Legal Affairs; Richard B. Lazarus, Supervisor of Patent Cooperation Treaty Legal; and the United States Attorney General (collectively "Defendants"). This action arises from Plaintiff's patent application under the Patent Cooperation Treaty.

Plaintiff filed his Amended Complaint on January 16, 1996, seeking relief on four counts. D. E. #28. As a result of Defendants' Motion to Dismiss, U.S. District Judge Jose A. Gonzalez, Jr. dismissed the third and fourth counts of the Amended Complaint. However, Judge Gonzalez also found that Plaintiff's first and second counts survived the motion to dismiss. D.E. #46.

In the first count, Plaintiff seeks a declaratory judgment that the Patent and Trademark Office's ("PTO") notice withdrawing acceptance of the application he filed on April 16, 1992, to commence the national stage of the Patent Cooperation Treaty ("PCT") is in violation of the PCT, its regulations, the Administrative Procedure Act ("APA"), and the Fifth Amendment of the United States Constitution. In the second count, Plaintiff seeks a writ of mandamus compelling the PTO to accept the April 16, 1992 application as sufficient to commence the national stage of the PCT.

Defendants now seek summary judgment on these two remaining counts. Plaintiff has filed a response, to which Defendants have replied.

STANDARD OF REVIEW

A party seeking summary judgment must demonstrate that "there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R.Civ. P. 56(c). The movant bears the initial responsibility of informing the Court of the basis for its motion and of identifying those materials which demonstrate the absence of a genuine issue of material fact. See Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S.Ct. 2548, 2553 (1986). In response to a properly supported motion for summary judgment, "the adverse party may not rest upon the mere allegations or denials of the adverse party's pleadings, but . . . must set forth specific facts which show a genuine issue for trial." Fed. R. Civ. P. 56(e). If the non-moving party fails to "make a sufficient showing on an essential element of her

case with respect to which she has the burden of proof," then the Court must enter summary judgment for the moving party. Celotex, 477 U.S. at 323, 106 S.Ct. at 2552.

"By its very terms, this standard provides that the mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 247-48, 106 S.Ct. 2505, 2510 (1986) (emphasis added). The Court is not to resolve factual issues, but may only determine whether factual issues exist. A material fact is one which "might affect the outcome of the suit under the governing law. . . . " Id. at 248, 106 S.Ct. at 2510. Therefore, the inquiry is whether "there are any genuine factual issues that properly can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party." Id. at 250, 106 S.Ct. at 2511.

DISCUSSION

The Patent Cooperation Treaty ("PCT") is an international treaty that allows an applicant to apply for a patent by filing one standardized "international application" in one member country, which ultimately results in separate applications in other member countries designated by the applicant. See United States Patent and Trademark Office Manual of Patent Examining Procedure §1801 (6th ed. rev. 1995).

There are essentially two stages to PCT applications, an international stage, and a national stage. The PCT process begins with the filing of an international application. During the international stage, the international application is processed under the terms of the PCT and its regulations. During the national stage, the international application is processed in each member country the applicant has designated, and considered

pursuant to the patent laws in that country. See id.; 25 U.S.C. §372(a).

In order to enter the national stage in the United States, an applicant must file in the Patent & Trade Office:

(1) the national fee
(2) a copy of the international application, unless already transmitted by the International Bureau;
(3) any amendments to the international application under Article 19 unless already transmit the International Bureau;
(4) an oath or declaration complying with 35 U.S.C. §115 and the pertinent regulations; and
(5) any translations where applicable.

35 U.S.C. §371(c). Failure to meet the requirements of section 371 (c) will result in abandonment of the international application in the United States. See 35 U.S.C. §371(d) [1].

According to the United States Patent and Trademark Office Manual of Patent Examining Procedure §1891, the papers sent by the International Bureau are matched with the applicant's submissions to form the national stage application. Once an application is complete, a notice of acceptance is mailed to the applicant, and the application is forwarded for further processing. Id.

On August 28, 1990, Plaintiff filed an international application pursuant to the PCT. On April 16, 1992, plaintiff attempted to commence the national stage of his

---

[1] Plaintiff argues that national law cannot conflict with or provide additional requirements to those which are provided for in the PCT treaty. See D.E. #61 at 3. Plaintiff has misconstrued the PCT which states that a nation may not require compliance with additional requirements relating to the form or content of the international application. See PCT Art. 27(1). This provision relates to additional requirements in the form of application under the PCT, not legal requirements pursuant to the nation's patent laws.

international application. Defendants claim that the April 16, 1992 application included five more claims and three more pages of specification not found in the original international application. Plaintiff admits to having added certain information, but contends that the paper contained sample calculations so that the examiner could more thoroughly understand the invention, and grammatical changes recommended by the international examiner. See D.E. #61 at 7-8.

On May 6, 1992, the PTO notified Plaintiff that the April 16, 1992 application was accepted for prosecution under the national stage of the PCT. However, on November 8, 1994, the PTO issued a notice vacating acceptance of the April 16, 1992 application. The reasons given for vacating the acceptance was that the declaration contained in Plaintiff's April 16, 1992 application identified the invention claimed in the national application, and not the invention claimed in the international application. Because the April 16, 1992 application and the international application were different, the PTO found that the April 16, 1992 declaration was insufficient to satisfy the requirements of 35 U.S.C. §371(c) (4). Accordingly, Plaintiff could not commence the national stage of his PCT application.

The November 8, 1994 notice from the PTO gave Plaintiff two options under which he could pursue his patent. Under the first option, Plaintiff could pursue the national stage of the PCT based on the original specifications and claims of the international application. This option prevented him from including in his national application the additional material found in the April 16, 1992 application[2]. However, the entire national stage application would be accorded the earlier filing date of the international application.

---

[2] Whether the additional material constitutes "new matter" is of significance in patent applications. This is because if "new matter" is not supported by or inherent in the application as originally filed, the PTO cannot legally accord

(continued....)

Pursuant to the second option, Plaintiff could pursue the application filed on April 16, 1992, as a national application regularly filed in the United States, without the benefit of the PCT and the international filing date. Plaintiff could, therefore, include the additional material, but the earlier filing date of the international application would only apply to material contained in or supported by that application. Newly-added material not found in or supported by the international application would receive an April 16, 1992 filing date.

In response to Plaintiff's December 6, 1994 petition protesting the November 8, 1994 notice, the PTO issued a decision on April 5, 1995 that proposed a third option. That option incorporated the second option of the November 8, 1994 notice, but also granted the entire April 16, 1992 application the benefit of the PCT's "unity of invention" standard [3].

Plaintiff's response to Defendants' Summary Judgement shows his frustration with the PTO's procedures. He disagrees that the additional material in the April 16, 1992 application is "new matter" that substantially changes the application. He argues that the PTO has yet to review the application to determine if the amendments he made to the application is in fact "additional material."

The PTO admits that it has not yet determined whether the additional material in Plaintiff's April 16,

---

[2] (....continued)
such material the filing date of the original application. See Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys., 804 F.2d 659, 664 (Fed. Cir. 1986); Litton Sys., Inc. v. Whirlpool Corp. 728 F.2d 1423, 1438 (Fed. Cir. 1984).

[3] Under this standard, if the examiner determines that there is more than one separate and distinct invention in his application, Plaintiff will be accorded the earlier filing date in so far as the inventions are supported by his international application.

1992 application is "new matter". Only after an international application has commenced the national stage is it forwarded to the appropriate examining group for a substantive examination by a patent examiner with technical training in the relevant field. See United States Patent and Trademark Office Manual of Patent Examining Procedure §1893.03 (6th ed. rev. 1995). Thus the PTO has yet to make a final determination as to whether Plaintiff's application will be accorded the earlier filing date as Plaintiff requests.

In view of the fact that the PTO has yet to render a final decision regarding whether the additional material in his April 16, 1992 application is "new matter", applicable law restricts the Court's ability to require that this additional material be accorded the earlier filing date. Although Plaintiff states repeatedly that the additional material is not "new matter", but rather sample calculations and grammatical changes recommended by the international examiner, until the PTO has determined this, the issue is not ripe for review. See Abbott Labs. v. Gardner, 387 U.S. 136, 148 - 49 (1967), overruled on other grounds, Califano v. Sanders, 430 U.S. 99, 105 (1977).

Furthermore, Plaintiff has not been precluded from including the additional material contained in the April 16, 1992 application. Pursuant to the PTO's third option, Plaintiff's April 16, 1992 application would be viewed as a national continuation-in-part application that would be entitled to the benefit of the earlier filing date to the extent that the additional material in the April 16, 1992 application is supported by the international application. To the extent that the additional material is not supported by the international application, it would receive the April 16, 1992 filing date.

As Judge Gonzalez noted in his Order on Defendant's Motion to Dismiss, " [s]imple utilization of one of the options given to Plaintiff by the Commissioner in the November 8, 1994 Notice and the April 5, 1995 Decision does not estop [Plaintiff] from arguing that the

additional material is not new matter." D.E. #46 at 3. Plaintiff is only precluded by law from automatically receiving the international filing date for the additional material at the time of filing his national stage application without any substantive review by the PTO. Thus, Defendants are entitled to Summary Judgment on the remaining two counts in Plaintiff's Amended Complaint.[4]

CONCLUSION

Accordingly, it is hereby ORDERED and ADJUDGED as follows:

1. Defendant's Motion for Summary Judgment (D.E. #55) is **GRANTED**.

2. Plaintiff's Motion for Sanctions (D.E. # 66) are **DENIED.**

3. This action is **CLOSED** and all pending motions not otherwise ruled upon are **DENIED as moot.**

DONE and **ORDERED** in Chambers, Miami, Florida, this 14 day of October, 1998.

sd./ LENORE C. NESBITT
UNITED STATES DISTRICT JUDGE

cc: Dr. Chacko P. Zachariah, pro se
Laurie E. Rucoba, AUSA
Suzanne Michel, Esq.

---

[4] Finally, Plaintiff seeks sanctions against Defendants for filing a motion for summary judgment on the same grounds stated in their motion to dismiss. Plaintiff fails to consider that the Court must apply a more rigorous standard when considering a motion for summary judgment. Thus, Plaintiff's Notion for Sanctions is **DENIED.**

(Order Entered on Aug 29, 1997 as DE # 67)

CLOSED CIVIL *CASE*

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
CASE NO. 95-6040-CIV-NESBITT

DR. CHACKO P. ZACHARIAH,
Plaintiff,

vs.

COMMISSIONER OF PATENTS & TRADEMARKS; et.al.,
Defendants

FILED by *sd/* D.C.
Aug 29, 1997
Clerk, U.S.District Court
S.D. Fla., Miami.

ORDER OF DISMISSAL

This cause comes before the Court upon a sua sponte review of the file. Rule 16.1.B of the Local Rules of the United States District Court for the Southern District of Florida requires that:

> Within twenty (20) days after the filing of an answer by the last answering defendant, or within sixty (60) days after the filing of a complaint (whichever shall first occur) in all civil actions, except those specifically excluded by subpart 9 of this subsection, counsel for the parties (or the parties (or the party if proceeding pro se) shall meet in person, by telephone, or be other comparable means...

S. D. Fla. L.R. 16.1.B. Local Rule 16.1.B.7 further requires that "[w]ithin ten (10) days after the meeting held pursuant to this subsection, those attending the meeting are mutually obligated to file the Scheduling

Report of Scheduling Meeting." S.D. Fla.L.R.16.1.B.7. Local Rule 16.1.M specifies that "[f]ailure to comply with the requirements of this rule will subject the party or counsel to appropriate penalties, including but not limited to dismissal of the cause...." S.D. Fla. L.R. 16.1.M.

On January 16, 1996, Plaintiff filed the Amended Complaint. On November 22, 1996 (D.E. #51), the last answering Defendant filed its Answer. Therefore, the parties should have met by December 12, 1996, and should have filed their Scheduling Report no later than December 27, 1996. However, as of the date of this Order, the parties have not filed the required Scheduling Report. Furthermore, subpart 9 of Local Rule 16.1.B does not exempt this action from the filing requirement.

Accordingly, it is hereby **ORDERED** and **ADJUDGED** that this matter is **DISMISSED** without prejudice, pursuant to Rules 16.1.B.7 and 16.1.M of the Local rules of the Southern District of Florida, for the parties' failure to file the Scheduling Report. The Court will retain jurisdiction over this action for ten (10) days from the date of this order to entertain motions to reinstate the action for good cause shown.

DONE and ORDERED in Chambers, Miami, Florida, this 28 day of August, 1997.

sd./ LENORE C. NESBITT
UNITED STATES DISTRICT JUDGE

cc: Dr. Chacko P. Zachariah, pro se
Laurie E. Rucoba, AUSA
Suzanne Michel, Esq.

(Order Entered on Oct 25, 1996 as DE # 46)

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 95-6040-CIV-GONZALEZ

DR. CHACKO P. ZACHARIAH,
Plaintiff,

v.

COMMISSIONER OF PATENTS & TRADEMARKS;
JAMES O. THOMAS, Jr., DAC for Patents;
CHARLES PEARSON, Head PCT Legal &
Office Administrator of Legal Affairs;
RICHARD B. LAZARUS, Supervisor-PCT Legal;
and UNITED STATES ATTORNEY GENERAL,
Defendants

ORDER

FILED by D.C.
Oct 25, 1996
Carlos Juenke, Clerk,
U.S.Dist Ct. S.D. Fla., FT. LAUD.

This Cause has come before the Court upon Defendants' Motion to Dismiss Amended Complaint, filed March 18, 1996. The motion has been fully briefed and is ripe for disposition.

When considering a motion to dismiss, the Court must first accept all of the Plaintiff's allegations as true. Scheuer v. Rhodes, 416 U S 232, 236, 94 S. Ct. 1683, 1686, 40 L.Ed 2d 90 (1974); Thomas v. Burlington Industries, Inc., 769 F Supp. 368, 370 (S.D.Fla 1991). The Court may not consider matters beyond the four corners of the Complaint. Milburn v. United States, 734 F.2d 762 (11th Cir.1984); Thomas 769 F Supp. At 370. The Court should not grant a motion to dismiss unless the Plaintiff can prove no set of facts in support of his claim

entitling him to relief. Conley v. Gibson, 355 U.S, 41, 45-46, 78 S.Ct. 99, 101-102, 2 L.Ed.2d 80 (1957).

Plaintiff has filed a four-count complaint, seeking declaratory judgment, writ of mandamus, writ of prohibition, and injunctive relief. After reviewing the allegations in this case, the Court concludes that the complaint alleges sufficient facts for Counts I and II (for declaratory judgment and for writ of mandamus) to survive the present motion.

The Court finds that plaintiff's third and fourth counts, for writ of prohibition and injunctive relief, are not ripe for review, and therefore shall be dismissed.

Under the Administrative procedure Act (APA), only agency action made reviewable by statute, and final agency action for which there is no other adequate remedy in court, are subject to judicial review. Preliminary and intermediate agency actions are reviewable qnly on review of the final agency action. 5 U.S.C. §704; Federal Trade Commission v Standard Oil Co , 449 U.S. 232 (1980).

In Count III, plaintiff seeks a writ of prohibition to prevent Defendants from selectively prosecuting his application. However, the PTO has not yet issued a final agency action imposing either a "unity of invention" or a "restriction" standard to plaintiff's patent application. In order to seek judicial review of the PTO's preliminary findings, Plaintiff must first request reconsideration by the examiner. 37 C.F.R. §1.143. If Plaintiff is still dissatisfied, he must then petition the Commissioner for review. 37 C.F.R. §1.144. The Court may entertain Plaintiff's Writ of Prohibition only after Plaintiff has exhausted both of these remedies.

In Count IV, Plaintiff seeks to enjoin Defendants from "tampering with the original filing status" of his patent application. Complaint at 25. To date, the PTO has not issued a final decision on whether the additional material submitted on April 16, 1992, is "new matter." The PTO has determined only that Plaintiff's April 16, 1992 papers contain material in addition to that

contained in the international application. A determination that material is "additional" is not the same as a determination that the material is "new matter" for purposes of determining' filing dates. Paperless Accounting v. Bay Area Rapid Transit System; 804 F.2d 659, 664 (Fed. Cir. 1986).

Simple utilization of one of the options given to Plaintiff by the Commissioner in the November 8, 1994 Notice and the April 5, 1995 Decision does not estop him from arguing that the additional material is not new matter. "The portion of Plaintiff's April 16, 1992 papers that was included in the international application would receive the filing date of the international application, as would any of the additional material which was supported by, or inherent in, the international application." Motion to Dismiss at 14, 15. The only portion of the additional material which would receive a filing date of April 16, 1992 is that which is not supported by the international application. Id.

To date, the PTO has not issued a final determination as to whether or not the April 16, 1992 material was inherent in the original papers. Plaintiff would be confronted with a potential estoppel situation only if the PTO made such a final determination, and if Plaintiff then accepted that determination and conceded its correctness. "Estoppel only arises when a clear, unambiguous rejection gives rise to a choice of appealing or accepting the rejection and the applicant accepts the rejection and expressly or impliedly concedes its correctness." Waldemar Link, GmbH & Co. v. Osteonics Corp., 32 F.3d. 556, 560 (Fed. Cir. 1994). Because the PTO has not issued a 'clear, unambiguous' ruling that the additional material in Plaintiff's April 16, 1992 papers is "new matter", Plaintiff has not yet had an opportunity to accept or reject the PTO's ruling. Therefore, prosecution history estoppel will not arise.

Plaintiff argues that in light of the Court's holding in Mark I Marketing Corp. v. R.R.Donnelley & Sons. Co., 66 F.3d 285, 36 U.S.P.Q.2d 1095, filing a Continuation-in-

Part, as recommended by the Commissioner, would result in an interpretation that he had conceded that the additional material filed on April 16, 1992 was new matter. The Court in Mark I states that "[t]he standard for determining whether particular subject matter was relinquished is an objective one that depends on what a competitor reasonably would conclude from the patent's prosecution history." Id. at 291.

In reference to the prosecution history, the Mark I Court states that "[t]he prosecution history must be examined as a whole in determining whether estoppel applies." Id., citing to Wang Lab., Inc. v Toshiba Corp., 993 F.2d 858, 867, 26 U.S.P.Q.2d 1767, 1775 (Fed. Cir. 1993). If the PTO makes a final determination that the material in the April 16, 1992 papers is not inherent in the international application, Plaintiff would then have the choice of appealing or accepting that determination. Waldemar link, 32 F.3d at 560. If, upon the PTO's final determination, plaintiff chooses to appeal that determination, such appeal would be part of the "prosecution history as a whole." Plaintiff's objections would be noted in a consideration of whether he had ever conceded that the April 16, 1992 material was new matter. At this point, the PTO has not issued a final decision that the additional material is "new matter" to a national stage or domestic application. Plaintiff's request for relief enjoining Defendants from "tampering with the original filing status" of his application is therefore not ripe for review.

Having reviewed the motion and the record, and being otherwise duly advised, it is hereby:

ORDERED and **ADJUDGED** that the Defendant's Motion to Dismiss Amended Complaint, filed March 18, 1996, is **DENIED** as to Counts I and II of plaintiff's Amended Complaint. Defendant's Motion is **GRANTED** as to Counts III and IV of Plaintiff's Amended Complaint. Counts III and IV shall be and the same are DISMISSED.

DONE AND ORDERED in Chambers at Fort Lauderdale, Florida, this 24th day of October, 1996.

sd./ JOSE A. GONZALEZ,
UNITED STATES DISTRICT JUDGE

cc: All Counsel
Dr. Chacko P. Zachariah, Pro Se

(Order Entered on Dec 19, 1995 as DE # 27)

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 95-6040-CIV-GONZALEZ

DR. CHACKO P. ZACHARIAH,
Plaintiff,

v.

COMMISSIONER OF PATENTS & TRADEMARKS; et al.,
Defendants

ORDER

FILED by *sd.* D.C.
Dec 19, 1995
- Carlos Juenke, Clerk,
U.S.Dist Ct. S.D. Fla., FT. LAUD.

THIS CAUSE has come before the Court upon Defendants'. Motion to Dismiss, flied on April 21, 1995.

Federal Rule of Civil Procedure 8(a) requires every complaint to contain "(1) a *short* and *plain* statement of the grounds upon which the court's jurisdiction depends..., (2) a *short* and *plain* statement of the claim showing that the pleader is entitled to relief, and (3) a demand for the relief the pleader seeks." Fed.R.Civ.P. 8(a) (emphasis added). Each averment should be simple, concise and direct. Fed. R. Civ. P. 8 (e). Moreover, the averments of a claim must be made in numbered paragraphs, each paragraph limited as far as practicable to the statement of a single set of circumstances. Fed.R.Civ.P. 10(b).

Plaintiff in this case submitted a twenty one page, frequently single spaced Complaint, replete with citations and arguments. Plaintiff's Complaint falls substantially short of complying with the simplicity and clarity dictates

of the Federal Rules. In addition, following the filing of Plaintiff's Complaint, the Commissioner of Patents altered his position with regard to Plaintiff's patent application. In light of the foregoing, Plaintiff will be ordered to redraft his Complaint. The Court has reviewed the motion and the record, and being otherwise duly advised, it is hereby:

ORDERED and **ADJUDGED** as follows:

1. The Court reserves ruling on Defendant's Motion to Dismiss.

2. Plaintiff is ORDERED to file an Amended Complaint within thirty (30) days from the date of this Order's entry, complying with the drafting requirements of the Federal Rules of Civil Procedure.

3. Plaintiff's Amended Complaint shall be limited to twenty five (25) pages in length, with each page containing no more than 260 words.

4. The application for relief in Plaintiff's Amended Complaint shall be made in light of the relief already provided by the Commissioner of Patents.

DONE AND ORDERED in Chambers at Fort Lauderdale, Florida, this 19th day of December, 1995.

sd./ JOSE A. GONZALEZ,
UNITED STATES DISTRICT JUDGE

Return Receipt Post Card Showing Proof of PTO's Receipt of Petitioner's Declaration for his Original PCT International Application.

The following was received today at the International Division of the U.S. PTO:

PCT Patent Application of DR. CHACKO P. ZACHARIAH for "ELEMENT AND ENERGY PRODUCTION DEVICE" for International Search by the U.S. PTO, 13 sheets of Specifications, 3 sheets of Claims, 1 sheet of Abstract, 1 sheet of Drawing, 3 sheets of PCT International Application Request (PCT/RO/101), Fee calculation sheet (PCT/RO/101 Annex), PCT International Application Transmittal Letter (PTO 1382), a cover Letter with **Declaration**, and CHECK # 176 for **US $2058.00**.

05 Rec'd PCT/PTO 28 AUG 1990

PCT/US90/04841

PTO SEAL
AUG 28 1990